

### **REMARKS**

This Amendment is filed in response to the Office Action dated May 7, 2007. In this Amendment, Claims 1-28 are amended and Claims 40-67 are added. Upon entry of this amendment, Claims 1-67 remain pending.

In the Office Action, Claims 1-39 have been rejected based on various prior arts grounds. For the reasons set forth below, these rejections are hereby traversed. Moreover, it is respectfully submitted that this Amendment resolves all remaining issues, thus placing all pending claims in condition for allowance.

#### **I. DOUBLE PATENTING**

The Examiner stated that Claims 1-39 conflict with claims 1-10 and 13-25 of Application No. 11/089,207 ("the '207 Application"). The '207 Application is a CIP of the present application and has two independent claims – Claims 1 and 14. Claim 1 recites an outer element that has an open area that constitutes at least about 20 percent of the surface area of device within the predetermined portion of its length. This is a feature that is not disclosed in the present application and is a patentable distinction over the presently disclosed invention. Claim 14 recites an outer element comprising a helically-wound filament defining a helical coil having a pitch that is greater than the diameter of the filament. This is also a feature that is not disclosed in the present application and is a patentable distinction over the presently disclosed invention. In light of these patentable distinctions, it is respectfully requested that the double patenting rejection be withdrawn.

#### **II. REJECTIONS UNDER 35 U.S.C. § 102**

The Examiner rejected Claims 1-3, 5-7, 14-18, 20-22, and 24 as being anticipated by *Jones et al.* (US 4,955,862, hereinafter "*Jones*"). The Examiner also rejected Claims 1, 4, 9, 14, and 19 as being anticipated by *Villar et al.* (US 5,669,931, hereinafter "*Villar*"). The Applicant respectfully disagrees with these rejections.

With regards to *Jones*, the Examiner states that *Jones* discloses a vaso-occlusive device including an outer element coaxially surrounding and in intimate contact with the intermediate element defining a gap or opening through which the intermediate element is exposed (12). This is incorrect. *Jones* does not disclose an outer element as claimed. Part 12, which Examiner points to, is a delivery catheter. Part 12 is not part of the occlusive device, nor does it define a gap or opening through which the intermediate element is exposed (Claim 1) or swells (Claim 14, as amended). To make this distinction more clear, the Applicant has amended Claims 1-28 to recite a vaso-occlusive implant rather than a vaso-occlusive device. Hence, the delivery device of *Jones* cannot be properly used to satisfy the claimed elements.

Claims 2-3, 5-7, 15-18, 20-22 and 24 are also patentable as being dependent on base Claims 1 and 14. Moreover, these claims are independently patentably distinct from *Jones*.

For example, the *Jones* device has no coupling element at its proximal end, as recited in Claims 5 and 20. The Examiner points to Col. 5, ll. 18-20 of *Jones* where it says the foam material is attached to the coil but the proximal end of the coil 20 is clearly depicted as being a free end, unconnected to anything.

The Examiner rejected Claims 1, 4, 9, 14, and 19 as being anticipated by *Villar*. Regarding Claim 1, fig. 7 of *Villar* does not show intimate contact between the inner and intermediate members except at the very ends of the device. To more clearly claim this distinction, Claim 1 has been amended to recite that the intimate contact occurs substantially along the length of the inner member. Fig. 4 does not show an inner member, or, in the alternative, does not show an outer member. There are only two members in fig. 4.

Claim 14 has been amended to recite that the outer element has an opening or gap through which the intermediate element swells. *Villar* clearly does not have this feature.

Claims 4, 9 and 19 are also patentable as being dependent on base Claims 1 and 14. Moreover, these claims are independently patentably distinct from *Villar*.

For example, Claim 4 recites an outer element that includes an open-wound, helically-coiled portion that defines the gap or opening through which the intermediate element is exposed. None of the outer windings shown in *Villar* are helical. The Applicant requests that Examiner look again at the structure of *Villar*. It is believed that upon further review, the Examiner will appreciate that the individual strands in the outer element are braided in a sinusoidal pattern. They do not encircle the device as would a helically wound strand.

As to Claims 9 and 24, the Examiner states that fig. 7 of *Villar* shows the coil shape of the intermediate element extending through the openings of the outer element such that each segment of the intermediate element that shows through is an arcuate segment, thus creating a convexly-curved chain. The Applicant strongly disagrees. The claims do not recite that the intermediate element shows through the outer element; the claims recite that the intermediate element extends through the outer element. The intermediate element of fig. 7 of *Villar* never extends through the outer element. The intermediate element of fig. 7 of *Villar* remains within the outer element along the entire length of the device.

The Applicant respectfully submits that all of the rejections under § 102 have been traversed by the above arguments and respectfully requests that these rejections be withdrawn.

### III. REJECTIONS UNDER 35 U.S.C. § 103

Claims 8 and 23 have been rejected under 35 U.S.C. § 103 as being unpatentable over *Jones* in view of *Dutta* (U.S. 6,623,450, hereinafter "*Dutta*"). The Examiner states that *Jones* fails to disclose the environmental parameter consisting of either temperature or pH, however *Dutta* provides this. However, Claims 8 and 23

depend from Claims 1 and 14, respectively. As argued above, Claims 1 and 14, as amended, are patentable over *Jones*. Hence, the Applicant respectfully requests that these rejections under § 103 be withdrawn.

#### **IV. NEW CLAIMS**

The Applicant has added new claims 40-67. Claims 40-65 were added to capture the subject matter indicated allowable by the Examiner. The Applicant thanks the Examiner for this indication of allowability. Claim 40 reflects the subject matter of Claim 10 rewritten in independent form. Claims 41 through 51 depend from Claim 40, directly or indirectly. Claim 52 reflects the subject matter of Claim 25 rewritten in independent form. Claims 53-65 depend from Claim 52, directly or indirectly.

Claims 66 and 67 are added to capture patentable subject matter not disclosed by the cited prior art. No new matter is added in Claims 66 and 67.

**CONCLUSION**


In view of the foregoing, it is submitted that all claims pending after entry of this amendment (namely, Claims 1-67) are in condition for allowance. Hence, entry of this Amendment is proper and is earnestly requested.

If any questions or issues arise that are more easily addressed by the Examiner through direct communication with the undersigned, the Examiner is cordially to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: November 7, 2007

  
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